

Appl. No. 09/545,336
Amdt. dated January 4, 2005
Reply to Office Action of October 4, 2004

REMARKS:

Status of claims:

The Examiner withdrew the rejections of the claims 1-2 over Morinaga in view of Wang, of claims 3-5 over Lane, and of 6-11 over Lane in view of Piosenska. The Examiner cited new art, rejecting claims 1-11 over U.S. Patent No. 6,219,439 to Burger in view of Morinaga; rejecting new claim 12 over Burger in view of Morinaga and in further view of U.S. Patent No. 5,802,199 to Pare; rejecting new claim 13 over Burger in view of Morinaga and in further view of U.S. Patent No. 4,975,969 to Tal; and rejecting new claim 14 over Burger in view of Morinaga and in further view of U.S. Patent No. 5,164,992 to Turk.

The Examiner also objected to claims 13 and 14 for minor matters requiring clarification. Claim 13 has been amended to delete the word "during," which was a typographical error. Claim 14 has been amended to clarify that "the sensor is an image-capturing device operable to capture at least two facial images of the individual."

Argument

Applicants thank the Examiner for the withdrawal of the previous rejections in light of the amendments made to claims 1-3, and are hopeful that prosecution may soon be drawing to a close.

Applicants respectfully traverse the rejections of claims 1-13, all of which depend upon a combination of the Burger and Morinaga references.¹ The Examiner's rejections over the course of prosecution seem to reflect a sense that the invention merely recites a combination of old elements.

The Applicants' invention is not just a combination of old elements. The combination provides important unexpected advantages over the prior art, many of which

¹ Claims 12, 13, and 14 are allowable because they depend from claim 3, which is allowable for the reasons cited elsewhere herein. Claim 12 deserves separate comment. It recites that the "personal identification device" is configured to automatically remove underutilized prerecorded representations of facial images. It is true that Pare describes a "local computer" that maintains a database of biometric samples of *multiple* users that "will eventually purge from its records the biometric sample and personal identification code of [a] relocated individual user." Col. 11, lines 45-48. Pare explains that "should [the] individual for example relocate to another area of the country," the individual will have to obtain access through a different local computer. Col. 11, lines 32-36. In other words, Pare's local computers are stationary. They do not travel with the user. The fact that individuals relocate, but Pare's local computers do not, provides Pare's motivation for purging a relocated individual's records. Claim 12, however, is concerned with a "personal identification device" that a user carries with him from one location to another, not a stationary computer dedicated to controlling access to a system. And claim 12 is not concerned with purging the "personal identification code," as does Pare – only underutilized facial images of the card owner. Pare does not provide any suggestion or motivation for purging only the underutilized facial images of a user (and not the user's entire identity) from a smart card.

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were cited in the 37 CFR 1.132 affidavit filed June 28, 2004. The Examiner's remarks seem to indicate that this affidavit was not considered because claims 1-3 were also simultaneously amended, rendering the previous rejections moot. That affidavit, however, not only distinguishes the claimed invention from match-on-card systems such as Lane, but also conventional smart card systems such as Burger. Applicants respectfully request consideration of the arguments set forth in that Affidavit, especially paragraphs 51-56, which recite various advantages of the claimed invention. While Applicants respectfully submit (as set forth below) that there is no prima facie basis for rejecting the claims, the unexpected advantages of the invention cited in the affidavit should be sufficient to overcome the Examiner's obviousness-based rejections.

But even if it is assumed that the claimed invention is nothing more than a combination of old elements, that does not render the claimed invention unpatentable. The Federal Circuit has repeatedly observed that "[m]ost if not all inventions arise from a combination of old elements."² "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue."³ The Federal Circuit has time and again categorically rejected the premise that mere combinations cannot be patented.⁴

Novel combinations of old elements cannot be rejected as obvious merely because they are combinations of old elements. "[I]nvention itself is the process of combining prior art in a nonobvious manner."⁵ The mere fact that the prior art *can* be combined or modified does not render the resultant combination or modification obvious.⁶ "The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'"⁷ Although a prior art reference "may be capable of being modified to run the way [an] apparatus is claimed, there must be a suggestion or motivation in the reference to do so."⁸

Applicants respectfully submit that the combination of Burger with Morinaga fails this critical inquiry. There is no suggestion or motivation in Burger, Morinaga, or any other prior art reference to combine the references together to replace the fingerprint scanner 16 on the Burger's smart card reader 18 with Morinaga's camera 28 embedded

² *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000).

³ *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

⁴ See, e.g., *Fromson v. Advance Offset Plate*, 755 F.2d 1549, 1556 (Fed. Cir. 1985) (holding that "[t]here is no basis in the law . . . for treating combinations of old elements differently in determining patentability" than any other claim).

⁵ *In re Rouffet*, 149 F.3d 1350, 1359 (Fed. Cir. 1998).

⁶ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990); *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

⁷ *Fromson v. Advance Offset Plate*, 755 F.2d 1549, 1556 (Fed. Cir. 1985) (quoting *Lindeman Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984)).

⁸ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990) (emphasis added).

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in the smart card 14 itself. Burger does not appreciate or recognize any benefit from making such a modification. And Morinaga certainly does not suggest one. Morinaga, after all, provides only passing reference to the camera 28. See col. 5, lines 38-43.⁹ Morinaga does not suggest any purpose for placing a camera 28 on the card. Morinaga does not suggest using it as part of a biometric identification system. In short, it neither teaches nor suggests a combination with Burger that would be covered by the claimed invention.

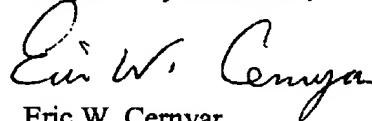
Applicants' invention has merit. It is novel. And because there was no teaching, suggestion, or motivation in the prior art to combine or modify the prior art to cover the claimed invention, it is also non-obvious. Prosecution has been ongoing for many months at great expense. The assignee is a very small company with limited resources. Applicants respectfully ask that they be given their constitutional and statutory due – that the claims be allowed and passed to issue.

Conclusion

Believing that all things raised in the Examiner's October 4, 2004, Office Action have been addressed, the undersigned respectfully requests withdrawal of the rejections of claims 1-14 and allowance and issuance of the application.

The Commissioner is authorized to deduct any fees that may be required from Eric W. Cernyar, P.C.'s deposit account no. 502906.

Respectfully submitted,



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⁹ Morinaga describes what is analogous to a PCI slot for a "portable electronic information device" like a portable computer or personal digital assistant. Morinaga says that the prior art includes "a card-shaped information medium 4 called an IC (integrated circuit) card having a memory function or the like." Col. 1, lines 19-21. The computer then uses "the memory or the like of the card-shaped information medium 4" to perform information processing. Col. 1, lines 19-27. According to Morinaga, a problem with the prior art was that the device body (e.g., the tablet computer, PDA, etc.) for receiving the card – not the card itself – was too bulky. Col. 1, lines 30-45.